

## REMARKS

In the January 17, 2006 Office Action, the Examiner noted that claims 1-29 were pending in the application, but claims 10-27 were withdrawn; rejected claims 1, 28 and 29 under the second paragraph of 35 U.S.C. § 112; rejected claims 1, 2 and 7 under 35 U.S.C. § 102(e); and rejected claims 4-6, 8 and 9 under 35 U.S.C. § 103(a). In the Office Action Summary, claims 3, 28 and 29 were indicated as rejected and claims 28 and 29 were discussed in the Detailed Action as if rejected under 35 U.S.C. § 102(e), but no indication of how or why claim 3 was rejected has been found. Claims 1-29 remain pending.

### Rejections under 35 U.S.C. § 112, Second Paragraph

On page 3 of the Office Action, claims 1, 28 and 29 were rejected under the second paragraph of 35 U.S.C. § 112 due to use of the word "parallel." Claims 1, 28 and 29 have been amended to delete this word and to clarify how the claims "correspond to a television program with merged commercials" (Office Action, page 3, line 12).

Withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested. If the claims are not found to meet the requirements of 35 U.S.C. § 112, the Examiner is respectfully requested to contact the undersigned prior to issuing another Office Action to discuss what further amendment of the claims is necessary to avoid another rejection under 35 U.S.C. § 112.

### Rejections under 35 U.S.C. § 102(e)

On pages 3-5 of the Office Action, claims 1, 2 and 7 were rejected under 35 USC § 102(e) as unpatentable over U.S. Patent 6,178,446 to Gerszberg et al. In the explanation of the rejection of claim 1 on page 4 of the Office Action, claims 28 and 29 were also discussed; therefore, it is assumed that claims 28 and 29 were also intended to be rejected as anticipated by Gerszberg et al.

As discussed in the Amendment filed with the Request for Continued Examination (RCE) on August 12, 2005, Gerszberg et al. describes a service for a subscriber who, "upon viewing a commercial on a display terminal can click on the advertisement to alert the advertiser that the customer is interested in the item that is being advertised" (column 2, lines 33-46) so that the subscriber can receive "an information pamphlet ... [or] a coupon, [or order] the product directly from the manufacturer or distributor" (column 2, lines 36-48). In response to selection of the advertisement by the subscriber, a subscriber request message is generated containing "the

subscriber's identity, the channel number that the subscriber was watching ... and a message type" (column 9, lines 44-48). This information is used to query a database "to determine the identity of the advertisement that was broadcasted by comparing the channel number and the time at which the advertisement was broadcasted with the channel number and time stored in the database" (column 9, lines 20-23) as indicated in block 410 in Fig. 9A. This enables "the additional information ... [to be] sent to the subscriber unit in step 420" (column 9, lines 49-51).

As also discussed in the August 12, 2005 Amendment, the independent claims all required "broadcasting, in parallel, both the commercial broadcast and the commercial message information relating to the commercial message broadcast" (e.g., lines 6-8 of claim 1 as previously presented), as indicated in block S410 in Fig. 4 and the XML data associated with reference numeral 50 in Fig. 8. The statement in the rejection of claims 1, 28 and 29 under the second paragraph of 35 U.S.C. § 112 that "the word 'parallel' will be treated as to correspond to a television program with merged commercials" (Office Action, page 3, lines 11-12) implied that the above-quoted limitation in claim 1 was not being interpreted as clearly recited in the independent claims or consistently with what is described in the specification, but instead for some reason was being interpreted as similar to what is disclosed in Gerszberg et al., even though there was nothing in the claim language to suggest such an interpretation.

To avoid an improper interpretation of the claim language, the independent claims that Examiner Rhode was willing to examine have been amended to recite "requesting a concurrent broadcast of the commercial message broadcast and the commercial message information relating to the commercial message broadcast generated according to the commerce information, during broadcast of a main program" (claim 1, lines 6-9); "requesting a broadcasting station to broadcast both the commercial message broadcast and the commercial message information relating to the commercial message broadcast concurrently during a main program" (claim 28, lines 7-9) and "the commercial message broadcast and the commercial message information relating to the commercial message broadcast are broadcasted concurrently during a main program" (claim 29, lines 9-11).

If the Examiner who replaces Examiner Rhode does not understand that this is different than what is taught by Gerszberg et al. because both "the commercial message broadcast and the commercial message information relating to the commercial message broadcast" are sent to subscribers during broadcast of a main program, the new Examiner is respectfully requested to contact the undersigned prior to issuing the next Office Action to provide an opportunity to

explain the differences in more detail so that examination of the application can proceed with little delay, despite the change in Examiners.

For the reasons discussed above, it is submitted that claims 1, 28 and 29, as well as claims 2 and 7 which depend from claim 1, patentably distinguish over Gerszberg et al.

#### **Rejections under 35 U.S.C. § 103(a)**

On pages 6-8 of the Office Action, claims 4-6 were rejected under 35 USC § 103(a) as unpatentable over Gerszberg et al. in view of U.S. Patent 5,774,534 to Mayer. Nothing was cited or has been found in Mayer that teaches or suggests modification of Gerszberg et al. to send both "the commercial message broadcast and the commercial message information relating to the commercial message broadcast" to subscribers during broadcast of a main program. Therefore, since claims 4-6 depend from claim 1, it is submitted that claims 4-6 patentably distinguish over Gerszberg et al. in view of Mayer at least for the reasons discussed above.

On pages 9-11 of the Office Action, claims 8 and 9 were rejected under 35 USC § 103(a) as unpatentable over Gerszberg et al. in view of U.S. Patent 6,587,838 to Esposito et al. Nothing was cited or has been found in Esposito et al. that teaches or suggests modification of Gerszberg et al. to send both "the commercial message broadcast and the commercial message information relating to the commercial message broadcast" to subscribers during broadcast of a main program. Therefore, since claims 8 and 9 depend from claim 1 it is submitted that claims 8 and 9 patentably distinguish over Gerszberg et al. in view of Esposito et al. at least for the reasons discussed above.

#### **Next Action Should Not Be Final**

Due to the lack of any reason for the rejection of claim 3 in the January 17, 2006 Office Action, it is submitted that the next Office Action should not be made final, because it will be the first opportunity to address the rejection of claim 3, since the filing of the August 12, 2005 RCE.

#### **Request for Examiner Interview**

If the rejections in the January 17, 2006 Office Action are not withdrawn, the Examiner who replaces Examiner Rhode is respectfully requested to contact the undersigned prior to issuing another Office Action to discuss what further amendments could be made to the claims to more clearly distinguish over the prior art.

**Request for Reconsideration of Restriction Requirement**

During the examination of the application, Examiner Rhode twice issued Office Actions considering claims 10-27 and then, after filing of an Amendment on August 12, 2005 which did not amend claims 1 and 10 differently, a Restriction Requirement was issued on September 29, 2005 refusing to continue the examination of claims 10-27. This change was explained in the January 17, 2006 Office Action as due to "a new interpretation" of the claims.

As discussed above, it is submitted that Examiner Rhode misinterpreted the independent claims in finding anticipation by Gerszberg et al. Since the Examiner who replaces Examiner Rhode will have to develop a new interpretation of claims 1-9, 28 and 29, the new Examiner is respectfully requested to also reconsider the interpretation of claims 10-27 as directed to a distinct invention for the reasons discussed in the Response to Restriction Requirement filed October 31, 2005.

**Summary**

It is submitted that the prior art references used to reject the claims do not teach or suggest the features of the present claimed invention. Thus, it is submitted that at least claims 1-9, 28 and 29 are in a condition suitable for allowance. Reconsideration of claims 10-27, in addition to claims 1-9, 28 and 29, and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 6/19/06

By: Richard A. Gollhofer  
Richard A. Gollhofer  
Registration No. 31,106

1201 New York Avenue, NW, 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450  
on June 19, 2006  
By: Richard A. Gollhofer  
Date: June 19, 2006